



Docket No.: 277923US6DIV

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RE: Application Serial No.: 09/842,542
Applicants: Masayuki NISHIGUCHI, et al.
Filing Date: April 26, 2001
For: AUDIO SIGNAL REPRODUCING APPARATUS
Group Art Unit: 2644
Examiner: Xu MEI

SIR:

Attached hereto for filing are the following papers:

**PETITION UNDER 37 CFR 1.137(b) FOR REVIVAL OF
AN APPLICATION ABANDONED UNINTENTIONALLY**

NOTICE OF APPEAL

Our credit card payment form in the amount of **\$2,000.00** is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R. 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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SOCKET NO: 277923US6DIV

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

APPLICATION OF

MASAYUKI NISHIGUCHI, ET AL.

SERIAL NO: 09/842,542

FILED: APRIL 26, 2001

FOR: AUDIO SIGNAL REPRODUCING
APPARATUS

:

: EXAMINER: XU MEI

:

: GROUP ART UNIT: 2644

:

**PETITION UNDER 37 CFR § 1.137(b) FOR REVIVAL OF
AN APPLICATION ABANDONED UNINTENTIONALLY**

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In accordance with the requirements of M.P.E.P. § 711.03(c), Applicants petition to revive this application which was unintentionally abandoned. The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR § 1.137(b) was unintentional.

A grantable petition requires:

(1) the petition fee set forth in 37 CFR § 1.17(m), which is enclosed herewith;

(2) the reply to the outstanding Office Action dated February 17, 2006, which is enclosed herewith; and

(3) a statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR § 1.137(b) was unintentional, which is given above.

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Further, a copy of the Office Action dated February 17, 2006 is attached hereto.

While Applicants were transferring this case to their new representative, an Office Action

Application No. 09/842,542
Reply to Office Action of

was issued and was not forwarded to Applicants and/or their new representative. Applicants' new representative learned of the Office Action on November 7, 2006. Applicants' new representative immediately filed a Power of Attorney, which was accepted on November 21, 2006.

Therefore, since all of the conditions are believed to have been met, revival of this application is earnestly requested.

The undersigned petitioner declares that all statements made herein of his own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing therefrom.

A prompt and favorable action upon this request is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Bradley D. Lytle
Attorney of Record
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/842,542	04/26/2001	Masayuki Nishiguchi		7853

7590

02/17/2006

Jay H. Maioli
Cooper & Dunham
1185 Avenue of the Americas
New York, NY 10036

EXAMINER

MEI, XU

ART UNIT

PAPER NUMBER

2644

DATE MAILED: 02/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.



Office Action Summary

Application No.

09/842,542

Applicant(s)

NISHIGUCHI ET AL.

Examiner

Xu Mei

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2005.
2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-17 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 4-17 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____

DETAILED ACTION

1. This communication is responsive to the applicant's amendment dated 11/29/2005.

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an

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invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1 and 4-17 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2 of U.S. Patent No. 6,695,477. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the application are broader than the ones in the patent. 214
U.S.P.Q. 761 In re Van Ornum and Stanz.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 4-17 are rejected under 35 U.S.C. 103 as being unpatentable over Yamamoto et al. (US-5,056,145, hereinafter,

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Yamamoto) in view of Yoshimura et al (US-4,764,965) and Shirai (JP 62-168,199).

Regarding claims 1 and 4-17, Yamamoto discloses a portable audio signal reproducing apparatus (as shown in Figs. 1-2 and 4-5) including a control circuit 13 (i.e., microcomputer) and signal processing circuit 15. Yamamoto also discloses the audio signal reproducing apparatus with the IC memory 10 (within an IC card 9) that is capable of storing sound data groups corresponding to musical sound or the like (col. 6, lines 33-41), and the IC card 9 (i.e., memory chip) is served as an external storage unit that is insertable into and detachable from (i.e., exchangeable or removable as claimed) the audio signal reproducing apparatus; the input unit or input section 11 including various user-activated interfaces that respectively trigger different functions by control circuit 13 for the audio apparatus is disclosed in Fig. 1, as per claim 1. An earphone 8 used for generating analog audio signals to the user is shown and would have met headphone driver unit as claimed. What does Yamamoto not teach is the portable audio signal reproducing apparatus including signal compression and decompression of the audio data using a high efficiency compression method, and left and right headphone driven unit for generating left and right audio channel audio sound.

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Yoshimura discloses an apparatus that including memory storage unit (10) for storing input and output audio data having audio signal compression and decompression circuits (data compression 12, data restoration 14 is for high efficiency audio signal processing) for audio signal processing (see Fig. 1 and col. 3, lines 10-31). It would have been obvious to one of ordinary skill in the art to modify the portable audio signal reproducing apparatus of Yamamoto by including audio signal compression and decompression circuits for audio signal processing as shown by Yoshimura in order to efficiently and effectively managing audio data to and from the IC memory.

Yamamoto discloses an earphone 8 used for generating analog audio signals to the user is shown and discussed above. Although Yamamoto discloses the portable audio signal reproducing apparatus in the preferred embodiment that it is being used for voice or speech signal recording and playback, there is no indication of the portable audio signal reproducing apparatus that cannot be used for other purpose, such as music recording and playback. As a matter of fact, Yamamoto discloses the portable audio signal reproducing apparatus is suitable for language speaking practice, musical training or the like (col. 1, lines 9-13). It is old and well known in the art at the time the invention was made that stereophonic headphone and driven

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unit (i.e., stereo amplifier) is available for generating stereophonic sound output. And Shirai discloses a semiconductor sound recording and playback apparatus in Fig. 1 including the old and well known stereophonic driven unit (i.e., stereo amplifier) for generating stereophonic output (L & R) through stereo speaker aa to user. It would have been obvious to one of ordinary skill in the art to further modify the improved portable audio signal reproducing apparatus of Yamamoto and Yoshimura as discussed above by including the old and well known stereophonic driven unit (i.e., stereo amplifier) with stereophonic headphone in order to provide user with high fidelity stereophonic output when the device is used in music training, for example.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Goldberg et al is made of record here as pertinent art to the claimed invention.

Goldberg et al discloses a portable random access audio recording and playback apparatus.

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7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Xu Mei whose telephone number is 571-272-7523. The examiner can normally be reached on Monday-Friday (9:30-6:00).

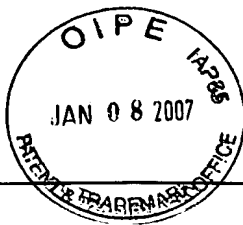
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivian Chin can be reached on 571-272-7848. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Xu Mei
Primary Examiner
Art Unit 2644
02/09/2006

**Notice of References Cited**Application/Control No.
09/842,542Applicant(s)/Patent Under
Reexamination
NISHIGUCHI ET ALExaminer
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U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-4,764,965	08-1988	Yoshimura et al.	704/278
*	B	US-5,359,698	10-1994	Goldberg et al.	704/201
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N	JP 62-168199	10-1987	JP	Shirai	G11C 27/00
	O					
	P					
	Q					
	R					
	S					
	T					

NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.